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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Reissue Application/reexamination of: **URANO** et al.

U.S. Patent No. **5,216,135**

Reexamination Control No.: **90/004,812** Filed: **October 23, 1997**

Reissue Serial Number: **09/810,650** Art Unit: **1626**

Issue Date: **June 1, 1993** Examiner: **Laura Lynne Stockton**

DECLARATION

1. I am the declarant who made the Declaration of May 20, 2002 in the above-identified reissue Application.

2. This Declaration is similar to my previous Declaration but supplemented to include my opinion with regard to claim 10 in the amendment submitted herewith.

3. I received a Ph.D. in organic chemistry from Northwestern University in 1954.

4. After receiving that degree, I was employed in the industry synthesizing organic compounds. Working with me were laboratory assistants having undergraduate degrees in chemistry.

5. I was given copies of and have read the following materials:

The PRELIMINARY AMENDMENT dated March 15, 2001, in the Reissue Application of U.S. Patent No. 5,216,135;

The RESPONSE dated May 22, 2002, in that application;

U.S. Patent No. 5,216,135;

An English translation of Japanese Patent Application No. 2-19614;

The DECISION in IN RE WAKO PURE CHEMICAL INDUSTRIES LTD. dated February 1, 2001; and

The attached copy of claim 10.

6. The definition of R^1_0 and R^2_0 in formula [1] of the Japanese Patent application is inclusive of "a C_{1-10} straight-chain, branched or cyclic alkyl group." (Page 9). R^1_0 and R^2_0 are further defined at page 14 of that Application (as translated) as inclusive of "methyl, ethyl, propyl, butyl, amyl, hexyl, octyl and decyl group."

7. The compounds of claims 8 and 9 of the Preliminary Amendment are compounds of formula [1] in the Japanese Patent application where both of R^1_0 and R^2_0 are a cyclohexyl group (claim 8) and where both of R^1_0 and R^2_0 are a branched butyl group (claim 9).

8. The compounds of claims 8 and 9 of the Preliminary Amendment are compounds of formula (I) in U.S. Patent No. 5,216,135 where R^1 is cyclohexyl (2:39) and R^2 is cyclohexyl (2:47) (in the case of claim 8), and R^1 is an isobutyl group, a sec-butyl group or a tert-butyl group (2:33-34) and R^2 is an isobutyl group, a sec-butyl group or a tert-butyl group (2:43-44) (in the case of claim 9).

9. The compound of claim 10 is a compound of formula [1] in the Japanese Patent application where both of R^1_0 and R^2_0 are cyclohexyl.

10. The compound of claim10 is a compound of formula (I) in U.S. Patent No. 5,216,135 where R^1 is cyclohexyl (2:39) and R^2 is cyclohexyl (2:47).

11. Based on my extensive experience in matters relating to the synthesis of organic compounds, it is my opinion that a person having an undergraduate degree in chemistry and several years experience in synthesizing organic compounds would know that "a C_{1-10} straight-chain, branched or cyclic alkyl group" is shorthand for and inclusive of each and every such alkyl group have 1-10 carbon atoms. This is particularly the case in view of the further description of the straight-chain, branched or cyclic alkyl group at page 14 of the Japanese application.

12. Based on my extensive experience in the matter relating to the synthesis of organic compounds, it is my opinion that a person having an undergraduate degree in chemistry and several years experience synthesizing organic compounds would know that the category of a branched butyl is synonymous with an "isobutyl group, a sec-butyl group or a tert-butyl group."

13. The paragraph bridging pages 2-3 of the DECISION reads, in part, "The written description requirement does not dictate that the applicant describe the invention exactly. Rather, what is required is that ... the inventor convey with reasonably [sic] clarity to those skilled in the art that the inventor was in possession of the subject matter claimed."

14. It is my further opinion that the Japanese patent Application establishes to an organic chemist of ordinary skill in the art that the inventors in the Japanese Patent Application were in possession of the compounds described in claims 8, 9 and 10.

15. It is also my opinion that U.S. Patent No. 5,216,135 establishes to an organic chemist of ordinary skill in the art that inventors in the '135 patent were in possession of the compounds described in claims 8, 9 and 10.

The undersigned declares further that all statements made herein of his own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of title 18 of the United States Code and that such willful statements jeopardize the validity of the application or any patent issuing thereon.

Signed this 12th day of December, 2002.

Albert Tockman

Claim 10. A diazodisulfone compound of the formula:

$$R^1SO_2CSO_2R^2$$
$$\|$$
$$N$$

wherein R^1 is cyclohexyl; and R^2 is cyclohexyl.